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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Satoshi EJIMA et al.

Group Art Unit: 2624

Application No.: 09/443,293

Examiner: S. Brinich

Filed: November 19, 1999

Docket No.: 104776

For: IMAGE PROCESSING APPARATUS HAVING IMAGE SELECTION FUNCTION,
AND RECORDING MEDIUM HAVING IMAGE SELECTION FUNCTION
PROGRAM

RESPONSE TO RESTRICTION REQUIREMENT

RECEIVED

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

OCT 23 2003

Technology Center 2600

Sir:

In reply to the September 10, 2003 Restriction Requirement, Applicant provisionally elects Group II, claims 22-24 with traverse.

The Office Action asserts that Groups I and II are related as combination and subcombination are restrictable because "the evaluation device may be implemented for evaluation of images with parameters other than compression" and "the subcombination has separate utility such as compression of a single image." Applicants respectfully disagree.

The claims of Group I are directed to an image processing apparatus having an image selecting function, comprising an evaluation device that performs acceptability evaluation on each of said plurality of sets of image data. See, for example, independent claim 1.

Similarly, the claims of Group II are directed towards an image processing apparatus having an image selecting function, comprising an evaluation device that performs acceptability evaluation on each set of image data. See, for example, independent claim 22. Thus, the

claims of Group II do not have "separate utility such as compression of a single image" as asserted by the Office Action.

Further, while claim 22 recites that the acceptability evaluation is based upon a resulting post compression code volume, it is respectfully submitted that this is not a separate utility from performing an acceptability evaluation in general. In other words, while the claims of Group II specify what the acceptability evaluation is based upon, both the claims of Group I and the claims of Group II recite the same utility of performing an acceptability evaluation via an evaluation device.

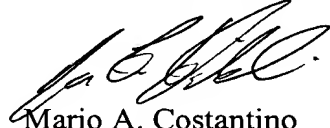
The Office Action further asserts that the claims of Group I have "separate utility such as evaluation of images produced without the use of a device with an acceptability selection mode and a continuous shooting mode." Applicants respectfully submit that this is not a proper statement of separate utility. Both the claims of Group I and the claims of Group III recite an evaluation device and an acceptability selection device/mode. See, for example, independent claims 1 and 25. In other words, while the claims of Group I and the claims of Group III arguably differ in scope, it is respectfully submitted that they have a common utility provided by an evaluation device and an acceptability selection device/mode.

It is also respectfully submitted that the subject matter of all claims 1-36 is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. For example, the claims of each of Groups I, II and III recite an evaluation device and an acceptability selection device/mode. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should

apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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